

Remarks: Claims 1-12, 24-28 and 30-32 are in condition for allowance

This is in response to the Office action dated May 28, 2008, in which claims 1-40 were pending and subject to a restriction and/or election requirement, claims 13-23, 29, and 33-40 are withdrawn from consideration, and claims 1-12, 24-28 and 30-32 were rejected.

The applicants respectfully submit that claims 1-12, 24-28 and 30-32, i.e. all currently pending claims, are presently in condition for allowance. With the present response, the applicants respectfully request that both the rejection of the claims in the prior Office action, and the finality of that rejection, be reconsidered and withdrawn, in light of the remarks below.

Parallel petition of restriction/election requirement

The applicants respectfully provide notice that, because the prior restriction/election requirement is being relied on as the basis for a final rejection, and the applicants believe the restriction/election requirement to be in error for purposes of the present final rejection, for the reasons indicated herein, the applicants are presenting a separate petition to the Director under 37 C.F.R. 1.144 from the restriction/election requirement as it applies to the present claims 1 and 27 as amended, in parallel to this response.

Amended claims 1 and 27 are not drawn to non-elected subject matter

The Office action indicates that the subject matter added by amendment to claims 1 and 27 in the applicants' response of March 4, 2008 ("the prior response") was disregarded for purposes of this Office action, as being directed to non-elected subject matter. The applicants respectfully submit that the subject matter of claims 1 and 27 as amended in the prior response is directed to subject matter that did not, in its entirety, appear in any previous claims, non-elected or otherwise, and therefore could not be drawn to a non-elected species.

The Office action indicates that the subject matter newly added to claims 1 and 27 is included in the non-elected species claims 15 and 16. However, only a portion of the newly added subject matter is actually recited in claims 15 and 16, while the totality of the newly added subject matter is not included in claims 15 and 16, or in any of the prior claims.

Specifically, claim 1 was amended as follows in the prior response, with markings reproduced to show the amended subject matter:

1. A suspension assembly comprising a suspension, a slider, and a suspension interface comprising a pivot and a pivot socket, wherein the pivot is rotatably engaged with the pivot socket, wherein the suspension interface ~~that~~ provides substantial freedom of rotation of the slider about a yaw axis relative to the suspension.

On the other hand, claims 15 and 16 read as follows:

15. The suspension assembly of claim 1, wherein the suspension interface comprises a pivot.
16. The suspension assembly of claim 1, wherein the suspension interface comprises a pivot socket.

Claim 15 therefore further limits claim 1 only to the extent of reciting that the suspension interface comprises a pivot, and claim 16 further limits claim 1 only to the extent of reciting that the suspension interface comprises a pivot socket. Withdrawn claim 35 recites certain analogous subject matter, but is dependent on a different parent claim, and also does not recite wherein the pivot is rotatably engaged with the pivot socket. On the other hand, claim 1 as amended also recites wherein the pivot is rotatably engaged with the pivot socket. This subject matter did not appear in any claim prior to the amendment of the prior response. Since it did not appear in any claim, it certainly did not appear in any previously elected or non-elected species.

Furthermore, when the restriction requirement was made, the Office indicated that claims 1 and 27 were among the claims that were generic to all indicated species (Office action of August 7, 2006, page 2, paragraph 3). The applicants submit that the Office was correct in that assessment, and that the amendments of claims 1 and 27 only further define the elected species within the scope of those originally generic claims.

Restriction of claims is improper because adding further limitations to a claimed species does not constitute a shift to a different, independent species

The applicants further submit that even if the subject matter newly added by amendment in the prior response had been limited to that of other, non-elected claims, its combination with the other subject matter of claims 1 and 27 without any subject matter being removed from claims 1 and 27 constitutes an acceptable further narrowing of the elected subject matter, not a shift to non-elected subject matter, since claims 1 and 27 are still directed to all the limitations of the elected subject matter in its original form, in addition to the narrowing amendments. (The applicants note that while some wording was struck in the amendment to claim 27, this wording was only rearranged rather than removed from the claim.) The applicants therefore respectfully submit that claims 1 and 27 as amended do not constitute independent and distinct inventions from the elected species.

While the Office action refers to 37 C.F.R. 1.142(b) and MPEP 821.03, the rule indicated therein provides only that an applicant may not shift from elected subject matter to non-elected subject matter, not that an applicant is barred from later narrowing the elected subject matter with a narrowing amendment that has any overlap with the non-elected subject matter. Rather, the opposite is the case, as MPEP 821.03 explicitly provides that “[t]he practice set forth in this section is not applicable... where applicant presents claims that could not have been restricted from the claims drawn to other elected invention had they been presented earlier.” Since the amendments to claims 1 and 27 only add further limitations to their subject matter, they do not give rise to independent and distinct inventions, and could not properly have been restricted from the original claims 1 and 27 if they had been presented earlier.

The Office action reasons that the newly amended claims are independent “or” distinct from the originally claimed invention. The applicants respectfully point out that restriction is only proper in the case of species that are both independent “and” distinct (37 C.F.R. 1.142(a)), and the Office action has explicitly applied an incorrect standard for evaluating whether restriction would be proper for claims 1 and 27 as amended. The applicants further submit that a claim that is amended only to add further limitations that narrow its scope, rather than an

amendment that eliminates some elements in exchange for others, by definition is not “independent” from the original form of that claim.

As defined by the restriction requirement, the defining elements of the elected species are directed to features associated with the air bearing surface of a slider, and the defining elements of the species of claims 14 and 15 are directed to features associated with the back surface of a slider. The differences used to try to define separate species are therefore no more than different perspective views of the same subject matter, for purposes of claims 1 and 27 in light of the previous election and amendments. Two perspective views of the same device from two different directions do not constitute two independent and distinct inventions.

The applicants therefore respectfully submit that claims 1 and 27 as amended are not directed to a new species because they are not independent from the subject matter already examined on the merits.

The applicants therefore respectfully request that the Office reconsider the withdrawal from consideration of the amended subject matter of claims 1 and 27, and instead examine claims 1 and 27 as amended on the merits, along with claims 2-12, 24-26, 28, and 30-32 as they incorporate the amended subject matter of claims 1 and 27. The applicants further request that the rejections of claims 1-12, 24-28 and 30-32 be reconsidered and withdrawn and that claims 1-12, 24-28 and 30-32 be allowed.

Premature final rejection

The applicants also submit that the final status of the latest Office action was premature, because the amendments to the claims were erroneously indicated to be drawn to non-elected species and the amendments and remarks in the applicants’ prior response were not considered on the merits. The applicants therefore respectfully submit that the Office action was not properly complete as to all matters under 37 C.F.R. 1.104(b), and request that the Office reconsider and withdraw the finality of the latest Office action, and treat that action as having been a non-final action. The applicants assert this to be a request for reconsideration of the finality of the rejection for the purposes of 37 C.F.R. 1.181(c).

Oumi does not anticipate claim 1 as amended

In the Office action, claim 1 was rejected under 35 U.S.C. §102(b) with reference to U.S. patent no. 6,473,384 issued to Oumi et al. The applicants have previously amended claim 1, and claim 1 as amended has not been examined on the merits. The claim amendments are well-supported by the specification. The applicants again submit that Oumi does not anticipate the subject matter of claim 1 as amended. As an illustrative example, Oumi does not disclose or suggest a suspension interface comprising a pivot and a pivot socket, wherein the pivot is rotatably engaged with the pivot socket. Therefore, the applicants respectfully submit that claim 1 is novel over Oumi under §102.

Kohira and Oumi do not render obvious claims 1-12, 24-28 and 30-32 as amended

In the Office action, claims 1-12, 24-28 and 30-32 were rejected under 35 U.S.C. §103(a) with reference to U.S. Patent No. 6,628,480 issued to Kohira et al. in combination with Oumi. The applicants have previously amended claims 1 and 27. Claims 2-12, 24-26, 28, and 30-32 are all dependent on claims 1 or 27 respectively, and also incorporate those amendments. The claim amendments are well-supported by the specification. Claims 1-12, 24-28 and 30-32 as amended have not been examined on the merits.

The applicants again submit that Kohira and Oumi do not render obvious the subject matter of claims 1 and 27 as amended. As an illustrative example, Kohira and Oumi do not disclose or suggest a suspension interface comprising a pivot and a pivot socket, wherein the pivot is rotatably engaged with the pivot socket, as in claim 1; nor do Kohira and Oumi disclose or suggest a means for operatively suspending a slider from a suspension, the means comprising a pivot and a pivot socket, wherein the pivot is rotatably engaged with the pivot socket, as in claim 27. Therefore, Kohira and Oumi do not render claims 1 or 27 obvious under §103.

Similarly, the applicants submit that claims 2-12, 24-26, 28, and 30-32 are non-obvious over Kohira and Oumi, due at least to the novel and non-obvious features they incorporate by dependency from claims 1 and 27 in accordance with the discussion above, in addition to their

further novel and non-obvious elements. The applicants therefore request that the rejections of these claims also be reconsidered and withdrawn in light of the amendments and remarks herein.

No narrowing interpretations implied

The foregoing remarks are intended to assist the Office in examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered exhaustive of the facets of the invention which are rendered patentable, being only examples of certain novel features and differences, which the applicants have opted to comment on as illustrative examples.

Furthermore, in commenting on the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and particular subject matter of the present application may have been commented on, even though such differences do not appear in all of the claims. It is not intended by commenting on any such distinctions to create any implied limitations in any particular claims of the present application.

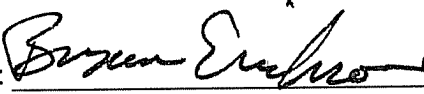
Conclusion: Claims 1-12, 24-28 and 30-32 are in condition for allowance

In view of the above remarks, the applicants respectfully submit that the pending claims are all presently in condition for allowance. The applicants therefore hereby request that the rejection of claims 1-12, 24-28 and 30-32 be reconsidered and withdrawn and that these claims be allowed.

The Director is authorized to charge any fee deficiency required by this paper or any paper in the prosecution of this application or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Bryan F. Erickson, Reg. No. 51,655
900 Second Avenue South, Suite 1400
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222
Fax: (612) 334-3312

BFE/eap